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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 10/581,166   | 05/31/2006  | Donald J. Marsh      | 21457P              | 3912             |
| 210 7590 09/16/2008<br>MERCK AND CO., INC<br>P O BOX 2000<br>RAHWAY, NJ 07065-0907 |             |                      |                     |                  |
| EXAMINER   |             |                      |                     |                  |
| TELLER, ROY R  |             |                      |                     |                  |
| ART UNIT   |             | PAPER NUMBER         |                     |                  |
| 1654   |             |                      |                     |                  |
| MAIL DATE  |             | DELIVERY MODE        |                     |                  |
| 09/16/2008   |             | PAPER                |                     |                  |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/581,166

**Applicant(s)**

MARSH ET AL.

**Examiner**

ROY TELLER

**Art Unit**

1654

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08 July 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) 1-5, 7, 8 and 11-15 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 6, 9 and 10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-8508)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date 7/17/08

### **DETAILED ACTION**

Applicant's election with traverse of the restriction requirement in the reply filed on 7/8/08 is acknowledged. The traversal is on the ground(s) that the compounds are related structurally and share a common utility. This is not found persuasive because each chemical entity has different substituents within the various variable positions and are distinct, each from the other. See restriction requirement, page 2.

The requirement is still deemed proper and is therefore made FINAL.

Applicant has elected compound A of example 4. Claims 1, 6, 9 and 10 are readable on this structure.

Claims 2-5, 7-8 and 11-15 are withdrawn as being drawn to a non-elected invention.

Claims 1, 6, 9 and 10 are under examination as they read upon the elected compound A.

### ***Information Disclosure Statement***

The information disclosure statement, received 7/17/06, is acknowledged. A signed copy is enclosed hereto.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1, 6, 9 and 10 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a method of inhibiting alcohol consumption comprising administering a therapeutically effective amount of a selective melanocortin 4 receptor agonist, that selective melanocortin 4 receptor agonist being compound A, does not reasonably provide enablement for a method of inhibiting alcohol consumption comprising administering a therapeutically effective amount of a selective melanocortin 4 receptor agonist. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to use the invention commensurate in scope with these claims.

In this regard, the application disclosure and claims have been compared per the factors indicated in the decision *In re Wands*, 8 USPQ2d 1400 (Fed. Cir., 1988) as to undue experimentation. The factors include:

- 1) the nature of the invention;
- 2) the breadth of the claims;
- 3) the predictability or unpredictability of the art
- 4) the amount of direction or guidance presented;
- 5) the presence or absence of working examples;
- 6) the quantity of experimentation necessary;
- 7) the state of the prior art; and,
- 8) the relative skill of those skilled in the art;

Each factor is addressed below on the basis of comparison of the disclosure, the claims and the state of the prior art in the assessment of undue experimentation.

The claimed invention is drawn to a method of inhibiting, reducing, or treating alcohol consumption/abuse comprising administering a therapeutically effective amount of a selective melanocortin 4 receptor agonist.

The breadth of the claims is excessive with regard to claiming a method of inhibiting, reducing, or treating alcohol consumption/abuse comprising administering a therapeutically effective amount of a selective melanocortin 4 receptor agonist.

Applicant has only provided guidance for the use of a method of inhibiting alcohol consumption comprising administering a therapeutically effective amount of a selective melanocortin 4 receptor agonist, that selective melanocortin 4 receptor agonist being compound A. Applicant have provided no guidance of any other compound which inhibits alcohol consumption. In absence of evidence to the contrary, it would not be expected that any and all selective melanocortin 4 receptor agonists would inhibit alcohol consumption.

Furthermore, it would not be predictable to the artisan which substance acts as a inhibitory substance would work in the present invention, nor would it be predictable to the artisan which pathologies could be treated with these ingredients that inhibit alcohol consumption or act as a inhibitory substance.

In consideration of these factors, it is apparent that there is undue experimentation because of a variability in prediction of outcome that is not addressed by the present application. Absent factual data to the contrary, the amount and level of experimentation needed is undue to practice the invention as claimed.

Accordingly, with respect to the elected invention, others skilled in the art would be unable to practice the invention as claimed without undue experimentation and with a reasonable expectation of success, other than using a selective melanocortin 4 receptor agonist, that selective melanocortin 4 receptor agonist being compound A to provide the functional effects instantly claimed, as shown in instant example 4, pages 23-24.

***Conclusion***

All claims are rejected.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ROY TELLER whose telephone number is (571)272-0971. The examiner can normally be reached on Monday-Friday from 5:30 am to 2:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cecilia Tsang, can be reached on 571-272-0562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

RT  
1654  
9/9/08

/Christopher R. Tate/  
Primary Examiner, Art Unit 1655